

### **REMARKS/ARGUMENTS**

Claims 1-3, 6-19, 22-34, 36, 38-39, and 41-49 are pending. The Office Action rejects Claims 1-3, 7, 9, 18, 22, 25-27, 36, 38-39, 44, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Outlook 97 ("Outlook") in view of U.S. Pat. App. Pub. No. 2005/0114453 to Hardt ("Hardt"). Claims 10-17, 29, 30-34, 42, and 45-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Outlook in view of U.S. Pat. App. Pub. No. 2005/0149622 to Kirkland et al. ("Kirkland"). Claims 6, 8, 23-24, 28, 41, and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Outlook and Hardt and further in view of U.S. Pat. No. 6,912,398 to Domnitz ("Domnitz").

In response to the Office Action, Applicants have amended several claims as set forth above in the listing of amended claims to further clarify and more particularly claim the invention. In light of the amendments and subsequent remarks, Applicants respectfully submit that the amended claims are patentably distinct from the cited references, taken alone or in combination, and are in condition for allowance.

#### **The Claim Construction Set Forth in the Office Action is Insufficient to Meet the Burden Imposed on the Office**

Initially, Applicants note that the Patent Office has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, "[t]he Examiner must make specific findings as to claim construction." *Ex parte Beery*, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte Blankenstein et al.*, Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07.

In the Office Action, the Office has failed to provide Applicants with a sufficient claim construction or interpretation of the cited references so as to enable the Applicants to make a fair review of the merits of the case of obviousness proffered by the Examiner, or to effectively reply. Other than quoting or paraphrasing Applicants' claim language

with annotated citations to figures, or column and line numbers of the cited references, the Examiner provides no finding or other explanation regarding several of the Applicants' claims, the cited references, or the application of the cited references to several of the Applicants' claims. The Board of Patent Appeals has found that the mere citing of passages of the prior art is insufficient to meet the Examiner's "initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention." *Ex parte* Beery, Appeal No. 2008-0543, page 5. As stated by the Board in *Ex parte* Beery, "The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations." *Id.*

In particular, the rejection of Claims 10, 12-16, 29-34, 42, and 45-47 fails to provide a sufficient claim construction in view of the requirements set forth by the Board of Patent Appeals. In rejecting Claims 10, 12-16, 29-34, 42, and 45-47, the Office appears to paraphrase features of Claim 10 and allege that those features are taught by the combination of Outlook and Kirkland, citing excerpts of those references. However, the Office Action does not provide any construction of Claims 12-16, 29-34, 42, and 45-47. Applicant therefore respectfully submits that the Examiner has failed to establish *prima facie* anticipation or obviousness of Claims 12-16, 29-34, 42, and 45-47. Should the Examiner continue to reject Claims 12-16, 29-34, 42, and 45-47 as being unpatentable over the same or any other ground, Applicants respectfully request that the Examiner submit on the record specific findings as to the construction being applied to the claims, an explanation of the references being cited against the claims, and how those references disclose recited features of the claims.

The Office Action Fails to Allege that Each Feature of Every Rejected Claim is Taught or Suggested by the Cited References

Applicants note that the Official Action fails to establish *prima facie* anticipation or obviousness of at least Claims 2, 18, 38, and 48. As stated in the MPEP, anticipation of the claimed invention requires the cited reference to explicitly or inherently teach each and every element of the claimed invention. MPEP § 2131. Likewise, all of the elements

of a claimed invention must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. MPEP § 2143.03 (*citing In re Royka*, 490 F.2d 981 (CCPA 1974)). In the instant case, however, the Official Action fails to allege Outlook, Hardt, Kirkland, Domnitz, or any other cited reference, taken alone or in combination, teaches or suggests each the features of at least Claims 2, 18, 38, and 48.

In this regard, the Office Action alleges that “the combination of Outlook and Hardt teaches the method of claim 1, wherein the step of receiving a generic-recipient message at a network hub further comprises receiving a generic-recipient message, chosen from the group of messages consisting of a Short Message Service (SMS) message, a Multimedia Message Service (MMS) message, electronic mail (email) message and voice message (Outlook, pg 55, email).” *See*, Page 4 of the Office Action. However, the Office Action does not even address the feature “determining a type of the message comprises determining whether the message comprises a Short Message Service (SMS) message, a Multimedia Message Service (MMS) message, electronic mail (email) message, or voice message” as recited in Claim 2 and similarly recited in Claims 18, 38, and 48, let alone allege that the feature is taught or suggested by Outlook or any of the other cited references, taken alone or in combination. Accordingly, Applicants submit that the Office has not established a *prima facie* case of anticipation or obviousness of any of Claims 2, 18, 38, and 48 and the rejections of Claims 2, 18, 38, and 48 are overcome.

#### The Examiner Has Not Fully Examined Claims 2, 18, 38, and 48

Applicants note that each of Claims 2, 18, 38, and 48 recites a Markush group. Specifically, Claims 2, 18, 38, and 48 recite “a generic-recipient message, chosen from the group of messages consisting of a Short Message Service (SMS) message, a Multimedia Message Service (MMS) message, electronic mail (email) message and voice message.” The MPEP states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, (emphasis added) even

though they may be directed to independent and distinct inventions. *See*, MPEP 803.02.

Each of the members of the Markush group cited by Claims 2, 18, 38, and 48 is a type of generic-recipient message as described in the specification and accordingly, search and examination of the entirety of Claims 2, 18, 38, and 48 can be made without serious burden. Thus, in accordance with the examination guidelines set forth in the MPEP, the Examiner must examine all of the members of the Markush group on the merits. However, the examiner has, at most, only examined electronic mail and cited the Outlook reference. The Examiner does not appear to have examined the remaining members of the Markush group.

Accordingly, Applicants respectfully submit that the Examiner has not fully examined Claims 2, 18, 38, and 48 and respectfully request that if the Examiner is to maintain the rejection of Claims 2, 18, 38, and 48 on the same or any other grounds that the Examiner fully examine each of the members of the Markush group.

Examiner's Failure to Fully Address Applicants' Traversals and Arguments Submitted in Previous Response

The Office has failed to fully respond to the Applicants' submitted arguments in previous responses. In the present Office Action, as best as the Applicants can discern given the failure of the Office Action to particularly address Claim 16, the Examiner continues to assert that Kirkland teaches the feature of prioritizing the communication medium used to dispatch the message. In the previous response, Applicants submitted the following argument:

Further, with respect to Claim 16, Applicants respectfully submit that none of the cited references, taken alone or in combination, teach or suggest prioritizing the communication medium used to dispatch the message. The Office Action appears to cite Kirkland as teaching this recitation. However, Kirkland at most teaches prioritizing an order in which a received instant message is displayed on a user's screen. Kirkland does not teach or suggest prioritizing the communication medium used to dispatch a generic-recipient message. For example, in the claimed

invention, a generic-recipient message sent from a predefined sender or messages including predefined content, such as, voice communication, may be dispatched by a telephone call or voice mail (e.g., in lieu of by email, SMS, or other communication medium). *See, e.g.*, page 17, lines 11-16 of the present application. As Kirkland relates only to prioritizing display of instant messages, Kirkland does not teach or suggest prioritizing the communication medium used to dispatch a generic-recipient message, nor do any of the other cited references, taken alone or in combination, teach or suggest this recitation. Accordingly, Applicants submit that Claim 16 is patentably distinct from the cited references, taken alone or in combination. Therefore, the rejection of Claim 16 is overcome and Claim 16 is in condition for allowance.

The present Office Action does not address Applicants traversal of the assertion that Kirkland teaches or suggests the feature of Claim 16 of prioritizing the communication medium used to dispatch the message. Applicants note that the Examiner is required to answer all material traversed:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given. (*Manual of Patent Examining Procedure* § 707.07(f))

Applicants accordingly respectfully request that if the Examiner is to continue to assert that Kirkland teaches this feature of Claim 16 in the future, the Examiner address the Applicants' asserted arguments.

The Rejection of Independent Claims 1, 22, and 36 under §103(a) is Overcome

The Examiner finds that independent Claims 1, 22, and 36 are obvious in light of the combination of Outlook and Hardt. Independent Claims 1, 22, and 36 are directed to a method, apparatus, and computer program product, respectively. For example, a method according to amended independent Claim 1 includes directing receipt of a generic-recipient message by a network hub. The generic-recipient message comprises a message sent to a group or community address. The method additionally includes determining predefined attributes of the message. The predefined attributes comprise one or more of a sender of the message, subject of the message, or content of the message. The method also includes determining a type of communication medium of the message. The method further includes determining one or more recipients for the message based at least in part upon the determined type and further based at least in part upon the predefined attributes by comparing the predefined attributes of the message with stored information related to potential recipients. The method also includes directing dispatch of the message to the one or more determined recipients. Claims 22 and 36 include similar recitations.

Applicants respectfully traverse the assertion that Outlook discloses the feature of determining a type of message as recited by Claims 1, 22, and 36. In this regard, “the message” for which a type is determined according to Claims 1, 22, and 36 is a received generic-recipient message. At most, Outlook teaches determining that an outgoing email is directed to a distribution group. Accordingly, Outlook does not teach or suggest determining a type of a received generic-recipient message as recited by Claims 1, 22, and 36. None of the other cited references, taken alone or in combination with Outlook, cure the deficiencies of Outlook and indeed are not cited for the proposition of teaching or suggest determining a type of a received generic-recipient message.

In spite of the clear patentable distinctions between Claims 1, 22, and 36, Applicants have amended Claims 1, 22, and 36 to recite determining a type of communication medium of the message in order to further clarify the patentable distinctions between the cited references and Claims 1, 22, and 36. In this regard, the received generic-recipient message may comprise one of several communication medium

types, including, for example, a short message service (SMS) message, a multimedia message service (MMS) message, an electronic mail (email) message, or a voice message. *See, e.g.*, page 5, lines 3-5; page 13, lines 4-14; and FIG. 2 of the application. The type of communication medium of a received generic-recipient message may be determined and the message may be dispatched based at least in part upon the determined type. *See, e.g.*, page 4, line 26- page 5, line 7, which describes determining predefined attributes of a message including a type and determining a recipient based on the predefined attribute (e.g., a type of communication medium ).

Accordingly, by the invention claimed in Claims 1, 22, and 36, a type of communication medium of a received generic-recipient message is determined and one or more recipients for the message are determined based at least in part upon the determined type. In contrast, Outlook, which the Office Action alleges teaches “determining a type of the message,” at most, discloses determining that an outgoing email message is a distribution group message. Accordingly, Outlook does not teach or suggest determining a type of communication medium of the received message. Indeed, such a determination would not be applicable to Outlook, which is a computer program for sending and receiving emails. Accordingly, determining a type of communication medium of a received message would not be applicable to Outlook. None of the other cited references, taken alone or in combination with Outlook, cures the deficiencies of Outlook.

As none of the cited references, taken alone or in combination, teach or suggest determining a type of communication medium of the received generic-recipient message, it consequently follows that none of the cited references, taken alone or in combination, teaches or suggests determining one or more recipients for the message based at least in part upon the determined type. Moreover, none of the other cited references, taken alone or in combination with Outlook and Hardt, cure the deficiencies of Outlook and Hardt. Applicants therefore respectfully submit that independent Claims 1, 22, and 36 are patentably distinct from the cited references such that the rejection of independent Claims 1, 22, and 36 is overcome and the claims are in condition for allowance.

The Rejection of Independent Claims 10, 29, and 45 under §103(a) is Overcome

The Examiner finds that independent Claims 10, 29, and 45 are obvious in

light of the combination of Outlook and Kirkland. Independent Claims 10, 29, and 45 are directed to a method, apparatus, and computer program product, respectively. For example, a method according to Claim 10 includes directing receipt of a generic-recipient message. The generic-recipient message comprises a message sent to a group or community address. The method further includes determining predefined attributes of the message, wherein the predefined attributes comprise one or more of a sender of the message, subject of the message, or content of the message. The method also includes determining a type of communication medium of the message. The method additionally includes determining whether the message has priority based at least in part on the determined type and on the predefined attributes by comparing the predefined attributes of the message with pre-stored priority information. Claims 29 and 45 include similar recitations and are directed to a device and computer program product, respectively. Although not included in Claims 29 and 45, Claim 10 additionally includes prioritizing the message when a determination is made that the message has priority.

Similarly to Claims 1, 22, and 36, Applicants have amended independent Claims 10, 29, and 45 to recite determining a type of communication medium of the received generic-recipient message. As discussed above, Outlook does not teach or suggest determining a type of communication medium of a received generic-recipient message as recited by amended independent Claims 10, 20, and 45. Moreover, as discussed above, none of the other cited references, including Kirkland, taken alone or in combination with Outlook, cures the deficiencies of Outlook.

Further, none of the other cited references, taken alone or in combination with Outlook teach or suggest determining whether the message has priority based at least in part on the determined type of communication medium in addition to the predefined attributes. The Office Action relies on Kirkland for teaching determining a priority. However, Kirkland does not teach or suggest determining a priority of a generic-recipient message. Moreover, Kirkland relates at most to prioritization only of instant messages. There is no suggestion in Kirkland that messages of multiple types of communication



mediums may be received and that a determination is made as to whether a received message has priority based at least in part upon a determined type of communication medium. Accordingly, Kirkland does not teach or suggest determining whether the message has priority based at least in part on the determined type of communication medium as recited by amended independent Claims 10, 20, and 45. Moreover, none of the other references, taken alone or in combination with Outlook and Kirkland, cure the deficiencies of Outlook and Kirkland

Accordingly, none of the cited references, taken alone or in combination, teaches or suggests amended independent Claims 10, 29, and 45. Therefore, Applicants submit that independent Claims 10, 29, and 45 are patentably distinct from the cited references such that the rejection of independent Claims 10, 29, and 45 is overcome and the claims are in condition for allowance.

#### The Dependent Claims are Patentably Distinct from the Cited References

Because the dependent claims include each of the recitations of a respective independent claim, Applicants further submit that the dependent claims are patentably distinct from the cited references, taken alone or in combination, for at least the reasons discussed above and are in condition for allowance.

In addition, with respect to Claim 16, Applicants respectfully submit that none of the cited references, taken alone or in combination, teach or suggest prioritizing the communication medium used to dispatch the message. The Office Action appears to cite Kirkland as teaching this recitation. However, Kirkland at most teaches prioritizing an order in which a received instant message is displayed on a user's screen. Kirkland does not teach or suggest prioritizing the communication medium used to dispatch a generic-recipient message. For example, in the claimed invention, a generic-recipient message sent from a predefined sender or messages including predefined content, such as, voice communication, may be dispatched by a telephone call or voice mail (e.g., in lieu of by email, SMS, or other communication medium). *See, e.g.*, page 17, lines 11-16 of the present application. As Kirkland relates only to prioritizing display of instant messages, Kirkland does not teach or suggest prioritizing the communication medium used to

dispatch a generic-recipient message, nor do any of the other cited references, taken alone or in combination, teach or suggest this recitation. Accordingly, Applicants submit that Claim 16 is patentably distinct from the cited references, taken alone or in combination. Therefore, the rejection of Claim 16 is overcome and Claim 16 is in condition for allowance.

## CONCLUSION

In view of the amended claims and remarks presented above, it is respectfully submitted that all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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